PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Didier RAOULT et al.

Application No.: 09/936,921

Filed: September 24, 2001

For: DIAGNOSIS OF WHIPPLE'S DISEASE

Group Art Unit: 1645

Examiner: P. Baskar

Docket No.: 110380

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the September 11, 2003 Restriction Requirement, Applicants provisionally elect Group I, claims 1-5, 10-11, 16-17 and 25-26, with traverse. This election is made with traverse for the following reasons.

I. Lack of Unity of Invention Has Not Been Demonstrated

The Office Action asserts that unity of invention does not exist, because Groups I-VII are directed to inventions that are not so linked as to form a single inventive concept. Applicants respectfully disagree.

A. Unity of Invention Exists Between Groups I & III-VI

Contrary to the assertion in the Office Action, the inventions of Groups I & III-VI are linked as to form a single inventive concept. In particular, each of Groups I & III-VI are substantially derived from the inventive concept of claim 1, that is, the bacterium *Tropheryma whippelii* responsible for Whipple's disease.

Group III is directed to antibodies raised against *T. whippelii*. The antibodies of Group III are defined with respect to the bacterium and antigens contained by the bacterium. The antibodies directed against *T. whippelii* share a technical relationship with the bacterium. Their relationship includes the special technical feature of at least the *T. whippelii* antigens and these antigens define at least one contribution made over the prior art. Accordingly, the special technical feature of Group I is also present in Group III. Because a common technical feature and single general inventive concept applies to this group of claims, unity of invention exists and restriction can not be required.

The methods of Groups IV-VI use the antibodies derived in Group III. The Examiner's attention is directed to Annex B, Part 2, of the PCT Administrative Instructions (MPEP Appendix AI). At least Examples 1 and 3 specifically demonstrate that unity of invention can exist between a substance and the use that substance. Example 1 demonstrates that unity exists between claims directed to substance X (i.e., an antibody directed to *T. whippelii*) and the use of substance X (i.e., diagnosis methods using the antibody). Example 3 demonstrates that unity exists between claims directed to a process that uses a composition containing substance X (i.e., a method for *in vitro* or serological diagnosis using an antibody directed to *T. whippelii*) and a composition containing substance X (i.e., test serum or biological fluid). In both instances, the special technical feature common to the claims is the antibody. These Examples further demonstrate that Groups I & III-VI posses unity of invention and should not be subject to a Restriction or Unity of Invention Requirement.

B. Unity of Invention Exists Between Groups I and Groups II & VII

Likewise, unity of invention exists as between Groups I and Groups II & VII. The Office Action has failed to establish any lack of unity of invention between these groups of claims.

As described above, unity of invention exists if there is a common special technical feature that links the groups of claims. In the present application, Group I is directed to isolated *T. whippelii* bacteria and bacterial antigens. Groups II &VII are directed to *T. whippelii* rpoB gene fragments, primers and probes, and methods using these fragments.

The Examiner's attention is again directed to Annex B, Part 2, of the PCT Administrative Instructions (MPEP Appendix AI). Example 17 specifically demonstrates that unity of invention can exist between a protein X (i.e., bacterial antigen) and a DNA sequence encoding protein X (i.e., rpoB gene). Because the protein and the DNA sequence exhibit special technical features unity between such claims is accepted. Furthermore, as detailed above, Examples 1 and 3 demonstrate that unity of invention can exist between a substance (i.e., rpoB gene fragments) and the use that substance (i.e., methods using these fragments).

C. Conclusion

Because the Office Action has not properly demonstrated an absence of unity of invention under the rules, and because unity of invention in fact exists between all of Groups I-VII, the Restriction Requirement is improper and must be withdrawn. Reconsideration and withdrawal of the Restriction Requirement are respectfully solicited.

II. There is No Undue Burden on the Examiner

It is also respectfully submitted that the subject matter of all claims 1-28 is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without

serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

For these additional reasons, restriction between Groups I-VII is also improper, and the Requirement should be withdrawn.

III. Conclusion

Should the Examiner have any questions regarding this response or the application in general, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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